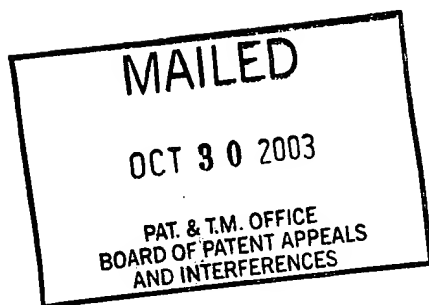


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte RICHARD CHANG
and
AMMY CHOU

Appeal No. 2003-1229
Application 09/739,990

ON BRIEF

Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR

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§ 1.196(a) and MPEP § 1211 for appropriate action with regard to items indicated below.

1. On January 24, 2002, the examiner issued a final rejection (Paper No. 11) including a rejection of claim 44 under 35 U.S.C. § 103(a) based on Chou (US 5,142,123), Netherlands 542,359 and Taiwanese 040,687. Although the examiner appears to have relied upon the entirety of each of the applied foreign language documents to support the § 103 rejection, it appears from the record that the examiner did not have a translation of each of the foreign language documents.

2. Appellants filed a Notice of Appeal on July 24, 2002 (Paper No. 14). A Supplemental Amendment and Appeal Brief were filed on November 25, 2002 and collectively entered on the file jacket as Paper No. 16. An Examiner's Answer was mailed on January 8,

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2003 (Paper No. 17). A Reply Brief was subsequently filed by appellants on March 10, 2003 (Paper No. 18) and acknowledged by the examiner as being "entered and considered" (Paper No. 19).

3. The application was then forwarded to the Board of Patent Appeals and Interferences, where a Docketing Notice was mailed on May 1, 2003 (Paper No. 20).

4. However, we note that in April of 2002, Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy, issued a memorandum addressing "Reliance upon abstracts and foreign language documents in support of a rejection." In that memo it is stated that "no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where: 1) a rejection is supported in whole or part by an abstract without

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reference to the underlying document . . . or 2) a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English." The memo expressly indicates that an examiner relying on a document in a language other than English must obtain a translation so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection and that it should be a "rare occurrence" that an examiner's answer is prepared where a rejection is based upon an abstract rather than the underlying document.

5. Since we find no translations obtained by the examiner in the current record, it is unclear as to the precise facts the examiner is relying upon to support the rejection of claim 44 before us on appeal.

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Accordingly, we REMAND the application to the examiner for clarification and to obtain appropriate translations of the foreign language documents relied upon.¹ As observed in the Memo from Deputy Commissioner Kunin, this will permit the examiner to consider the patentability of the claims in light of a fuller set of facts. The examiner's assessment of the full text documents (translations) in support of the rejection under 35 U.S.C. § 103(a) would appropriately be set forth in a supplemental answer, with appellants having the right to respond thereto.

¹ The examiner should note that what appears to be an English language version of Taiwanese 040,687 is attached to the copy of this foreign language document in the record. However, there is no indication that the examiner actually relied upon the English language version of the Taiwanese document. No translation of Netherlands 542,359 appears in the record.

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6. The examiner's assertion on page 5 of the answer that Netherlands '359 "only shows said metal press plate is secured to a base (10) instead of a press bar," appears to be inconsistent with the examiner's earlier finding near the top of page 5 that it is Taiwanese '687 which shows a metal press plate (14) secured to a base (10). Clarification is required.

7. In addition to the foregoing, it does not appear from the record that the examiner has provided any indication to appellants concerning entry or non-entry of the amendment filed on November 25, 2002, or made a notation on the amendment itself concerning entry/non-entry thereof. Thus, we also REMAND for correction of this oversight as well.

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This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Aug. 2001. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMAND TO THE EXAMINER

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

Lawrence J. Staab
LAWRENCE J. STAAB

LAWRENCE J. STAAB
Administrative Patent Judge


JENNIFER D. BAHR

JENNIFER D. BAHR
Administrative Patent Judge

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